Panel Decision for dispute CAC-ADREU-002753

Case number	**CAC-ADREU-002753**
Time of filing	**2006-10-24 14:00:28**
Domain names	**xtrack.eu**

Case administrator

Name	**Tomáš Paulík**

Complainant

Organization / Name	**Sportvertrieb Danuta Badziag, Ulrich Greune**

Respondent

Organization / Name	**EURid**

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

No pending legal proceedings related to the disputed domain name have been reported by the parties or are known to the Panelist.

FACTUAL BACKGROUND

The Complainant, Danuta Badziag, is a natural person resident within the European Community (Germany). She applied for the domain name xtrack.eu on 8 December 2005. She provided documentary evidence in support of that application on 16 January 2006, which was before the 17 January 2006 deadline. The documentary evidence submitted by the Complainant in support of the application consisted of a trademark certificate issued by the German Patent and Trademark Office for the figurative trademark Nr 301 68 926 [x-track]. The validation agent concluded from its examination of the documentary evidence that the trademark Nr 301 68 926 could not serve to establish the prior right claimed for the domain name XTRACK. EURid rejected the application on the grounds that the evidence received by the validation agent did not sufficiently prove the claimed right. The Complainant launched his complaint on October the 24th, seeking the annulment of the Respondent's decision to reject his application regarding the disputed domain. On the same day the CAC acknowledged the receipt of the complaint, and indicated both the assigned case number and the case administrator to the Complainant. Following that, the CAC requested from EURid verification with regard to the particulars included in the complaint. The Respondent provided the CAC with the above on 2.11.2006. On the 3rd of November the CAC proceeded to the complaint check, and notified the respective deficiencies to the Complainant. Following correspondence between the CAC and the Complainant, the latter sent a revised version of his complaint, which showed no deficiencies. Hard copies of the complaint were also received by the CAC, according to ADR Rules. The formal date of the commencement of the ADR Proceeding was 13.11.2006, as stated by the CAC, and communicated to the Respondent. EURid's response was received on 28.12.2006, as evidenced by the Acknowledgement of Receipt of the Response, posted on the case file details. The CAC has chosen the undersigned to serve as a Panelist, whose statement of Acceptance and Declaration of Impartiality and Independence was notified to the CAC on 29.12.2006. At the same day the CAC proceeded to the Notification of Appointment of the ADR Panel and Projected Decision Date, which is scheduled for the 28th of January 2007 the latest. The parties did not exercise their right to challenge the appointment.

A. COMPLAINANT

The complainant states that he is the owner of a registered national trademark [x-track] in Germany, identical to the domain name under dispute. He submits attached the respective certificate of registration (Nr. 301 68 926, as Annex 1 of his complaint). He claims that he fulfills the requirements of Art. 10 (1) of the Public Policy Rules. In addition, he underlines that the application documents were filed according to the rules and regulations, completely and correctly. Following the above he sees no reason to reject the application for the domain name xtrack.eu. He therefore asks for the annulment of the Respondent's decision and the acceptance of his application.

B. RESPONDENT

The Respondent refers to Art. 10 (2) of the Regulation 874/2004 and Section 19 (2) of the Sunrise Rules, in order to justify the decision

taken by the Validation Agent and the Registry as well. It underlines that the application was for the domain name xtrack.eu, while the registered trademark in Germany, which was supposed to serve as a prior right basis for the application, included a hyphen [x-track]. Therefore, according to the provisions aforementioned, this application could not be accepted, since the words included in the trademark (including hyphens) were not identical to the domain name applied for.

Additionally, a number of respective .eu ADR case law was brought before this Panel by the Respondent, in order to support its Response. I will deal with these decisions later on.

The Respondent also underlines that the hyphen is not a special character in the meaning of article 11 of the Regulation. Therefore, the hyphen should be included in the domain name applied for. This point is very important in the present case, because the reason for the rejection of the application is precisely the hyphen in the prior right.
Finally, the Respondent notes that the Applicant also applied for the domain name X-TRACK (including the hyphen as it appears on the trademark) on 7 December 2005. The Applicant was the first in line for this domain name and the Respondent validated its application, which shows coherence in the Respondent's decisions.
For all reasons stated above, the Respondent is of the opinion that the complaint should be denied.

DISCUSSION AND FINDINGS

In the Panel's view, one should begin from the relevant provisions dealing with the subject matter.
Article 10 (2) of the Regulation states that "the registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists".

Section 19 (2) of the Sunrise Rules further stipulates the following: "Documentary Evidence must clearly depict the name for which a Prior Right is claimed. A Prior Right claimed to a name included in figurative or composite signs (signs including words, devices, pictures, logos, etc.) will only be accepted if (i) the sign exclusively contains a name, or (ii) the word element is predominant, and can be clearly separated or distinguished from the device element, provided that (a) all alphanumeric characters (including hyphens, if any) included in the sign are contained in the Domain Name applied for, in the same order as that in which they appear in the sign".

The conclusion which can be reached from the above provisions, is that a domain name and its supporting prior right should be identical in all alphanumeric characters. In the case brought before this Panel the facts – as evidenced by the case file – are the following: The figurative trademark submitted as documentary evidence by the Complainant consists of the following elements:
(1) a figurative element consisting of the letter X inside a rectangular shape; and
(2) the alphanumeric characters "-TRACK".

Pursuant to section 19 (2) (ii) of the Sunrise Rules, the Registry must clearly separate the alphanumeric from the device elements, in order to proceed to the registration of the word elements of the prior right. In this case, as evidenced by the trademark certificate attached to the complaint, this was not a difficult task, since only the rectangular shape is not an alphanumeric character. Without this device element, the general impression of the word "X-TRACK" is apparent, without any reasonable possibility of misreading the characters of which the sign consists or the order in which those characters appear. Therefore, all alphanumeric characters (including hyphens, if any) included in the sign "X-TRACK" should have been contained in the domain name applied for, in the same order as that in which they appear in the sign.

The Complainant did not provide any further arguments or earlier .eu ADR decisions, in order to support his complaint. The Respondent on the other side mentioned several decisions regarding the interpretation of Art. 10 (2) Regulation 874/2004 and 19 (2) Sunrise Rules, namely ADR 1053 (SANTOS), 713 (HUETTINGER), 01438 (ELLISON), 00470 (O2), 1728 (ANONSE, OFERTA), 1427 (BONOLLO), 2061 (MODLINE), 1973 (ICG), 2297 (FENRISULVEN), 2680 (SIEBERT) and 1364 (GUTSCHEINBUCH). In addition, the Respondent quoted passages from two more decisions, i.e. ADR 1262 (NATIONALBANK) and ADR 1951 (XFAB). Save the last decision, the rest dealt with the (deliberate) failure of complainants to apply for the complete name of their sign, leaving out additional words or letters included in the prior right deposited as documentary evidence. It is true that case 1262 deals with the hyphen issue as well, but this point was not the relevant one at that particular dispute.

In case 1951, the Panel cleared out that the expression "complete name", as stipulated in Art. 10 (2) Regulation 874/2004, is equal to an identical application for a domain name registration. In this respect the Panel stated that "[a]lthough Article 11 sets out a number of specific exceptions, in relation to special characters and spaces, the special characters do not include hyphens, and in the Panel's view, the wording of Article 11 is to be construed restrictively. The cases included in Article 11 refer only to those special characters which cannot be reproduced in a domain name. In contrast, it is technically possible to register domain names including a hyphen. The hyphen should therefore not be seen as one of the special characters included in Article 11".
The potential insignificance of hyphens within the .eu registration system was – as already said – not stressed out by the Complainant,

whose complaint lacked of any argumentation with regard to a possible constructive approach of Art. 11 of Regulation 874/2004 in her favour; still, this Panel would like to express its accordance with the findings contained in case 1951, and to mention recent decisions following the same direction [see ad hoc case 2706 (na-ag), and generally concerning the interpretation of Art. 10 (2) Regulation 874/2004, case 2742 (telecare), 3032 (seghorn), 3226 (caravanclub), 3285 (giebel), 3310 (medium), 3492 (mapco), 3366 (ciao), 3213 (tat), 3593 (centric), and 3529 (salzburgerland)]. Finally, special mention needs to be made to the decision taken in case 3116 (schein), which accepts the complaint and annuls the decision of the Registry to register the disputed domain name in favour of the applicant, who presented its company name as prior right, consisting of the words “Schein Orthopaedie Service KG”.

Accordingly, as the Complainant applied for the XTRACK domain name (and not for the X-TRACK domain name), the Respondent had no other option than to reject the Complainant’s application. This decision was in accordance with Art. 10 (2) Regulation 874/2004.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12 (b) and (c) of the Rules, the Panel orders that

the Complaint is Denied

PANELISTS

Name	**Apostolos Anthimos**

DATE OF PANEL DECISION 2007-01-17

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant applied for the domain name xtrack.eu on 8 December 2005. The documentary evidence submitted by the Complainant in support of the application consisted of a trademark certificate issued by the German Patent and Trademark Office for the figurative trademark “x-track”. EURid rejected the application. The Complainant launched his complaint on October the 24th, seeking the annulment of the Respondent’s decision to reject his application regarding the disputed domain name.
Pursuant to Art. 10 (2) Regulation 874/2004 and Section 19 (2) of the Sunrise Rules a domain name and its supporting prior right should be identical in all alphanumeric characters. Since the Complainant’s prior right included a hyphen, an application for a domain name registration based on the prior right aforementioned cannot exclude the hyphen, but needs to be identical to the indication presented as a prior right. The hyphen is not a special character in the meaning of article 11 of the Regulation. Therefore, the hyphen should be included in the domain name applied for.